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| APPLICATION NO.                            | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/724,187                                 | 11/27/2000  | Todd Bartleson       | NAIIP137/00.123.01  | 7757             |
| 28875                                      | 7590        | 06/17/2004           | EXAMINER            |                  |
| SILICON VALLEY INTELLECTUAL PROPERTY GROUP |             |                      | AKPATI, ODAICHE T   |                  |
| P.O. BOX 721120                            |             |                      | ART UNIT            |                  |
| SAN JOSE, CA 95172-1120                    |             |                      | PAPER NUMBER        |                  |

2135  
DATE MAILED: 06/17/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/724,187

Applicant(s)

BARTLESON ET AL.

Examiner

Tracey Akpati

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/27/00.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. <u>Attachment</u>                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. As per the phone interview with the attorney on 4/16/04, it was suggested to the attorney by the examiner to amend the limitation of the independent claims, namely Claim 1 so as to put the case in a possible condition for allowance. After a meeting with my SPE, regrettably the claims did not meet this expectation. The examiner regrets any disappointments this has caused to the attorney and/or applicant.

Following a phone conversation with the attorney, the examiner disclosed this to the attorney and the attorney suggested to send in another amendment to alleviate the broadness and 112 issues within the independent claims, namely Claim 1. A further pre-amendment was received by fax from the attorney on 5/28/04. This pre-amendment eliminates the trademark "Palm operating system" and hence eliminates the possible 112 rejection. However, the attorney's pre-amendment does not further narrow the scope of the claims so as to put the case in a condition for allowance. Hence a non-final rejection has been made for this case as shown below.

#### ***Claim Rejections - 35 USC § 112***

Claim 13, 14 and 16 recites the limitation "said request". There is insufficient antecedent basis for this limitation in the claim. Claim 14 is rejected by virtue of dependency. Since there is more than one request, the limitation "said request" lacks sufficient antecedent basis.

#### ***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 7, 8, 13, 14, 16-18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkinson et al (6367012 B1).

With respect to Claim 1, the limitation of "monitoring calls to applications resident on the handheld computer" is met on column 2, lines 35-40 and 44-52; and "identifying a code associated with a program initiating said call" is met on column 3, lines 13-24; and "at least temporarily preventing an action requested by said call from being executed if the identified code does not correspond to a code associated with data said action is to be performed upon" is met on column 9, lines 9-20; and "wherein identifying a code comprises identifying a creator code on a handheld computer operating system; wherein the creator code is used to prevent malicious behavior" is met in the abstract. The signature/certificate represents the creator code because it verifies the integrity and authenticity of the file/program being downloaded to the computer so as to prevent any kind of malicious behavior/code.

It would have been obvious to have a handheld computer in place of the computer disclosed in Atkinson et al because a handheld computer is simply a computer, with all its working properties and capabilities, but shrunk in size. Moreover, according to *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976), 'the mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled.' 531 F.2d at 1053, 189 USPQ at 148.

With respect to Claim 6, the limitation of “identifying at least one of the applications as a trusted application, wherein trusted applications are not prevented from performing actions” is met on column 3, lines 18-24.

With respect to Claim 7, the limitation of “receiving data on an infrared port of the handheld computer and installing said data in a temporary database” is met on column 2, lines 8-12. The sandbox/playpen provides a temporary storage database or medium for the suspicious program. The handheld device is obvious for the reasons disclosed in Claim 1.

With respect to Claim 8, the limitation of “asking a user whether to accept said data before loading said data onto the handheld computer” is met inherently in column 9, lines 9-20. The handheld device is obvious for the reasons disclosed in Claim 1.

With respect to Claim 13, the limitation of “monitoring requests for action by applications on the handheld computer” is met on column 2, lines 35-40, 44-52; and “evaluating said requests to determine if said requests may result in potentially harmful behavior to data stored on the handheld computer” is met on column 2, lines 35-40, 44-52; and “preventing said action from being performed if said request is identified as potentially harmful behavior” is inherently on column 3, lines 47-58; and “notifying a user of the handheld computer of said potentially harmful behavior” is met on Fig. 6; and “wherein evaluating said requests comprises

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comparing a creator code associated with the application requesting said action with a creator code associated with data the action is to be performed upon; wherein the creator code is used to prevent malicious behavior” is met on column 3, lines 14-24.

The signature/certificate represents the creator code because it verifies the integrity and authenticity of the file/program being downloaded so as to prevent any kind of harmful behavior/code.

It would have been obvious to have a handheld computer in place of the computer disclosed in Atkinson et al because a handheld computer is simply a computer, with all its working properties and capabilities, but shrunk in size. Moreover, according to *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976), ‘the mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled.’ 531 F.2d at 1053, 189 USPQ at 148.

With respect to Claim 14, the limitation of “wherein monitoring requests for action comprises monitoring API calls” is met on column 26, lines 7-17, 26-39; column 30, lines 27-33.

With respect to Claim 16, the limitation of “identifying at least one application as a trusted application and allowing said action to be performed even if said request is identified as potentially harmful if requested by the trusted application” is met on column 2, lines 6-11.

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With respect to Claim 17, its limitation is similar to Claim 1 limitation and hence its rejection can be found therein.

With respect to Claim 18, its limitation is similar to Claim 6 limitation and hence its rejection can be found therein.

With respect to Claim 20, its limitation is similar to Claim 13 limitation and hence its rejection can be found therein.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkinson et al (6367012 B1) in view of Walsh et al (5956481).

With respect to Claim 2, all the limitation is met by Atkinson et al except for the limitation disclosed below.

The limitation of "wherein monitoring calls to applications comprises installing a patch on the handheld computer, the patch being operable to intercept calls" is met on Walsh et al on column 2, lines 6-16.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Walsh et al within the system of Atkinson et al because installing a patch will enable the computer processes to execute the patch in place of the original, less secure routines in order to ensure the system is immune from malicious attack/code.

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With respect to Claim 3, all the limitation is met by Atkinson et al except for the limitation disclosed below.

The limitation of “wherein installing a patch comprises replacing an API address with a patch address” is met by Walsh on column 2, lines 6-16.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Walsh et al within the system of Atkinson et al because replacing an API address with a patch address will enable the computer processes to execute the patch in place of the original, less secure routines in order to ensure the system is immune from malicious attack/code.

With respect to Claim 4, all the limitation is met by Atkinson et al except for the limitation disclosed below.

The limitation of “wherein installing a patch comprises utilizing get trap and set trap commands” is inherently met by Walsh on column 2, lines 6-16.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Walsh et al within the system of Atkinson et al because the trap commands are inherent routines executable with a patch, enabling the patch to do its job.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkinson et al (6367012 B1) in view of Chess (5572590).

With respect to Claim 9, all the limitation is met by Atkinson et al except for the limitation disclosed below.



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The limitation of “wherein the action requested is a password manipulation” is met by Chess on column 1, lines 49-55 and on column 2, lines 8-13.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chess within the system of Atkinson et al because a malicious change could be easily categorized as a password manipulation. Hence Chess’s disclosure can be taken to cover a password manipulation.

With respect to Claim 10 and 11 all the limitation is met by Atkinson et al except for the limitation disclosed below.

The limitation of “wherein the action requested is deletion/modification of data” is met by Chess on column 1, lines 49-55 and column 2, lines 8-13.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chess within the system of Atkinson et al because deletion/modification of data is a malicious change to data stored on a computer. Hence Chess’s disclosure can be taken to mean deletion/modification of data.

With respect to Claim 12, all the limitation is met by Atkinson et al except for the limitation disclosed below.

The limitation of “wherein the action requested is manipulation of an operating system” is met by Chess on column 1, lines 49-55 and on column 2, lines 8-13.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chess within the system of Atkinson et al because

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unauthorized manipulation of an operating system is a malicious change to data stored on a computer. Hence Chess's disclosure can be taken to mean manipulation of an operating system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracey Akpati whose telephone number is 703-305-7820. The examiner can normally be reached on 8.30am-6.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703-305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OTA

*Tracey Akpati*  
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